



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|-------------------------|---------------------|------------------|
| 10/048,244 | 08/27/2002 | Donald K. Blumenthal II | 0274-3858.1US | 2667 |

7590 02/25/2005

TraskBritt
PO Box 2550
Salt Lake, UT 84110

EXAMINER

SODERQUIST, ARLEN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

1743

DATE MAILED: 02/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|-------------------------------|---------------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/048,244 | Applicant(s) BLUMENTHAL, DONALD K. | |
| | Examiner Arlen Soderquist | Art Unit 1743 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

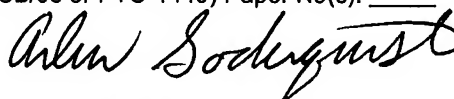
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-27.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.



ARLEN SODERQUIST
PRIMARY EXAMINER

Continuation of 11. does NOT place the application in condition for allowance because: of the reasons of record and the following comments. First relative to the Packard '97 and Packard '98 references applicant referred to page 4, lines 17-19 to show the scope of covalent modifications to the molecule's backbone. The reference should have been to lines 14-19. In lines 14-17 the scope of applications to which the assay methods can be applied is defined as "structural modifications to biomolecules". This is clearly a scope that is larger than what applicant is arguing. Second, even in lines 17-19, referred to by applicant, there is an important distinction between the language of the claims and the scope which applicant is arguing. In lines 17-19 the qualifier "which do not result in the cleavage of the biomolecule" is added to limit the type of covalent modifications. Thus one of skill in the art would have recognized that covalent modifications of the backbone to include both cleavage and noncleavage modifications. Thus the argument is not commensurate in scope with the language of the claims and this qualifier should be added to limit the claims to the scope of the arguments. Third, at least claim 1 and those dependent therefrom are directed to a molecule having a particular property. It is well established that a molecule may inherently have a claimed property even though the property is not disclosed in the reference. In this respect the presence of a modifiable group in the backbone is sufficient to shift the burden to applicant to show that the property is not found in the molecule(s) of the reference. In the Packard references the NorFES sequence has at least two modifiable groups on the serine and lysine amino acids that are part of the backbone. Relative to the rejections based on references in view of Packard '98 or de Silva, these rejections are not obviousness rejections since the Packard '98 and de Silva are only used as teaching references. They teach that there are multiple mechanisms that can be responsible for energy transfer in the molecules disclosed in the main references, rather than modifying the structure of the references. Since the arguments to these references are similar to those of the Packard references, the above comments are appropriate. Relative to the obviousness rejection the arguments are not commensurate with the scope of the claims as set forth above. furthermore it appears that applicant is arguing that any possible combination of the teachings of the references is outside of the instant claims. If this is that case please cancel dye and backbone combinations that are taught by the combination of references or limit the claims to the specifically exemplified structures of the instant specification .